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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Tara J. Valentin

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HOFFMAN WARNICK & D'ALESSANDRO, LLC
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ALBANY, NY 12207

EXAMINER

STEPHENS, JACQUELINE F

ART UNIT

PAPER NUMBER

3761

DATE MAILED: 06/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/871,717

Applicant(s)

VALENTIN ET AL.

Examiner

Jacqueline F Stephens

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 4/26/04, 5/28/04.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-63 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-63 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Since the Advisory Action mailed 5/19/04 shows the amendment filed 4/26/04 to have been not entered, the Request for Continued Examination specifically, section 1.a. requests entry of the aforementioned amendment, and is considered applicant's response. The request for consideration is considered proper, thus applicant's submission filed on 4/26/04 has been entered. All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and additional arguments have not been presented. Therefore, the examiner is repeating the arguments set forth in the previous Advisory Action.

Response to Arguments

2. Applicant's arguments filed 4/26/04 have been fully considered but they are not persuasive. Applicant argues "the Roe diaper is designed such that the top front of the diaper is aligned with the top back of the diaper. Figure 3. The present invention includes a back guard that extends vertically from the rear portion of the diaper. Thus, Roe does not have a back guard as contained in the present invention". Roe teaches

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an invention with a fold down waist feature that enables the user to longitudinally extend the diaper in the back waist region, resulting in a high back or low back configuration. The rear of the diaper can not be aligned with the front of the diaper in both the high back and low back configurations.

Applicant further argues "high back configuration" of Roe does not denote a middle back area of a user. Roe specifically teaches the rear waist region extends longitudinally outwardly from the rear waist edge. However, 'high back configuration' and 'middle back area' are relative terms - relative to the size of a user. Applicant further argues the high back configuration of the waist feature in Roe simply allows the Roe diaper to be worn as a regular diaper at or about the waist and the range of lengths is specifically designed to provide the optimum range of lengths to allow the back member to extend to the middle back of the user, depending on the user's size. Firstly, the term "high back configuration" connotes the diaper reaches the back of a user. The examiner maintains applicant has not provided criticality for the specific length since in applicant's disclosure, page 9, it states "Accordingly, it should be realized that length 30 of back guard 18 can be of any value or range of values between 1.0 and 24.0inches. These possible lengths and/or ranges of lengths are intended to apply to all embodiments of the present invention described herein" Therefore, one could also argue the lower range of the length of the back guard , 1", would not reach a middle back area of a user, particularly on an adult diaper. Roe provides the teaching of longitudinally extending a diaper from the waist in the rear region. In *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir.

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1984), cert. denied, 469 U.S. 830, 225 USPQ 232 (1984), the Federal Circuit held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-3, 12, and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Roe et al. USPN 5989236.

As to claim 1, Roe discloses an incontinence article **20** comprising a front portion **34**, a rear portion **38**, and a back guard **62** extending vertically from the rear portion to a middle back area of a user (Figures 1 and 6; col. 1, lines 43-45 and col. 9, lines 38-41).

As to claim 2, Roe discloses tabs 44 for coupling the front portion to the rear portion (Figure 1 and col. 6, lines 7-9).

As to claim 3, Roe discloses the back guard further comprises a flap **92** that may be made of any known material suitable for use in a disposable absorbent article, such as the same material as the topsheet (col. 4, lines 41-44 wood or cotton fibers and rayon fibers, which are all absorbent materials). The flap 92 is centrally located centrally on the back guard (Figures 10 and 11).

As to claim 12, see Figure 11.

As to claim 13, see Figure 6.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 4-11, 14-21, 29, and 43-55 rejected under 35 U.S.C. 103(a) as being unpatentable over Roe et al. USPN 5989236.

As to claims 4-7, Roe discloses the back guard comprises elastics and the guard is elastically extensible in one or more directions. However, Roe is silent as to where the elastic is positioned. The back guard of Roe serves to elongate the diaper so it can fit a variety of users, and is elastically extensible for this purpose. It would have been an obvious matter of design choice to have the elastic materials on the entire back guard or on the periphery, since either structure would elongate the back guard so as to fit a variety of users and contain exudates, and since applicant has not disclosed limiting the elastic to the periphery solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with the elastic in other regions of the back guard.

As to claim 8, the side portions of the back guard are curved, Figure 9.

As to claim 9, the side portions of the back guard are linear, Figure 8.

As to claims 10, 11, 14, 20, and 21 Roe does not disclose the back guard has a length of approximately 1.0 – 10.0 inches. It is evident that Roe has a value for the length of the back guard. Roe recognizes the length of the back guard should be

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sufficient to adjust in length to fit a large range of wearer sizes and to provide an absorbent article, which can be fitted to a wearer in a high-back configuration (col. 1, lines 39-45). It would have been an obvious matter of design choice to provide the article of Roe with the claimed dimensions, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

Roe discloses an incontinence article **20** comprising a front portion **34**, a rear portion **38**, and a back guard **62** extending vertically from the rear portion to a middle back area of a user (Figures 1 and 6; col. 1, lines 43-45 and col. 9, lines 38-41). Roe further discloses the back guard further comprises a flap **92** that may be made of any known material suitable for use in a disposable absorbent article, such as the same material as the topsheet (col. 4, lines 41-44 wood or cotton fibers and rayon fibers, which are all absorbent materials). The flap **92** is centrally located centrally on the back guard (Figures 10 and 11).

The vertical extension of Roe is capable of extending to a middle back area of a user. For instance, is the elongated diaper of Roe is designed to adjust to the size of various users (col. 7, lines 55-62). Therefore, if the diaper is placed on a smaller infant, the diaper would extend to a middle back area of the infant as opposed to the same diaper being used on a toddler.

As to claims 15, 16, and 19, Roe discloses the back guard comprises elastics and the guard is elastically extensible in one or more directions. However, Roe is silent as to where the elastic is positioned. The back guard of Roe serves to elongate the diaper so it can fit a variety of users, and is elastically extensible for this purpose. It would have been an obvious matter of design choice to have the elastic materials on the entire back guard or on the periphery, since either structure would elongate the back guard so as to fit a variety of users and contain exudates, and since applicant has not disclosed limiting the elastic to the periphery solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with the elastic in other regions of the back guard. Roe further discloses the back guard is curved (Figures 9 and 11).

As to claim 17, the side portions of the back guard are curved, Figure 9.

As to claim 18, the side portions of the back guard are linear, Figure 8.

As to claims 29, 43-47, and 50-53, Roe does not disclose the back guard has a length of approximately 1.0 – 10.0 inches. It is evident that Roe has a value for the length of the back guard. Roe recognizes the length of the back guard should be sufficient to adjust in length to fit a large range of wearer sizes and to provide an absorbent article, which can be fitted to a wearer in a high-back configuration (col. 1, lines 39-45). It would have been an obvious matter of design choice to provide the article of Roe with the claimed dimensions, since such a modification would have

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involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

Roe discloses an incontinence article **20** comprising a front portion **34**, a rear portion **38**, a crotch portion **36**, and a back guard **62** extending vertically from the rear portion to a middle back area of a user (Figures 1 and 6; col. 1, lines 43-45 and col. 9, lines 38-41). The back guard comprises opposing horizontal extensions **44**. Roe further discloses the back guard further comprises a flap **92** that may be made of any known material suitable for use in a disposable absorbent article, such as the same material as the topsheet (col. 4, lines 41-44 wood or cotton fibers and rayon fibers, which are all absorbent materials). The flap **92** is centrally located centrally on the back guard (Figures 10 and 11).

Roe discloses the back guard comprises elastics and the guard is elastically extensible in one or more directions. However, Roe is silent as to where the elastic is positioned. The back guard of Roe serves to elongate the diaper so it can fit a variety of users, and is elastically extensible for this purpose. It would have been an obvious matter of design choice to have the elastic materials on the entire back guard or on the periphery, since either structure would elongate the back guard so as to fit a variety of users and contain exudates, and since applicant has not disclosed limiting the elastic to the periphery solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with the elastic in other regions of the back guard. Roe further discloses the back guard is curved (Figures 9 and 11).

As to claim 48, see Figure 11.

As to claim 49, Roe discloses tabs 44 for coupling the front portion to the rear portion (Figure 1 and col. 6, lines 7-9).

As to claim 54, the absorbent material is flap **92** is separately positioned from the elastic in guard **62** (Figure 10).

As to claim 55, Roe discloses the flap **92** can be integral with other elements, which includes guard **62**, therefore, the absorbent material is flap **92** is commonly positioned from the elastic in guard **62** (col. 8, lines 46-50).

8. Claims 22-24, 26, 28, 30-42, and 60-63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Allen et al. USPN 5106385 in view Roe.

As to claims 22, 23, 30-35, 37, 60, 62, and 63 Allen discloses an incontinence article **10** comprising: a front portion **19**, a rear portion **18** joined to the front portion, and a back guard **40** extending from above the rear portion (Figure 3A). The back guard extends above the front portion when the article is worn by a user (Figures 3B and 3C shows the extension panel increasing the size of the diaper. Allen discloses the back guard comprises a cloth or fabric, but is silent as to whether the back guard **40**

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comprises an absorbent material. Roe discloses an incontinence article having a back guard, which further comprises a flap **92** that may be made of any known material suitable for use in a disposable absorbent article, such as the same material as the topsheet (col. 4, lines 41-44 wood or cotton fibers and rayon fibers, which are all absorbent materials). The flap **92** is centrally located centrally on the back guard (Figures 10 and 11). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the back guard of Allen to include an absorbent material as disclosed in Roe. Doing so would provide a back guard that is soft feeling and nonirritating to the wearer's skin (Roe col. 4, lines 37-39 and col. 8, lines 45-50).

Allen does not disclose the back guard **40** comprises elastic material. Roe discloses the back guard comprises elastics and the guard is elastically extensible in one or more directions for the benefit of providing improved fit (Roe col. 7, lines 55-60). It would have been obvious to provide the back guard of Allen with elastics for the benefits disclosed in Roe.

Allen/Roe is silent as to where the elastic is positioned. The back guard of Allen/Roe serves to elongate the diaper so it can fit a variety of users, and is elastically extensible for this purpose. It would have been an obvious matter of design choice to have the elastic materials on the entire back guard or on the periphery, since either structure would elongate the back guard so as to fit a variety of users and contain exudates, and since applicant has not disclosed limiting the elastic to the periphery solves any stated problem or is for any particular purpose and it appears that the

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invention would perform equally well with the elastic in other regions of the back guard.

The back guard comprises a vertical extension and opposing horizontal extensions (Allen Figures 3A-3C).

As to claims 24 and 26, see Allen, Figures 3A-3C.

As to claims 28, 41 and 42, Allen/Roe does not disclose the back guard has a length of approximately 1.0 – 10.0 inches. It is evident that Allen/Roe has a value for the length of the back guard. Allen/Roe recognizes the length of the back guard should be sufficient to adjust in length to fit a large range of wearer sizes and to provide an absorbent article, which can be fitted to a wearer in a high-back configuration (Allen col. 1, lines 40-49; Roe col. 1, lines 39-45). It would have been an obvious matter of design choice to provide the article of Allen/Roe with the claimed dimensions, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

As to claim 36, see Allen Figures 3A and 3B.

As to claims 38 and 39, see Allen Figure 3C.

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As to claims 40 and 61, the vertical extension of Allen/Roe is capable of extending to a middle back area of a user. For instance, is the elongated diaper of Allen/Roe is designed to adjust to the size of various users (Allen col. 1, lines 40-49). Therefore, if the diaper is placed on a smaller infant, the diaper would extend to a middle back area of the infant as opposed to the same diaper being used on a toddler.

9. Claims 25 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Allen in view of Roe as applied to claim 22 above and further in view of Goyal USPN 6119275.

Allen/Roe discloses the present invention substantially as claimed. However, Allen/Roe does not disclosed the back guard **40** is curved. Goyal discloses a back guard **1** that is curved for the benefit of conforming to the shape of the wearer's back (Goyal col. 1, line 66 through col. 2, line 2). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the back guard of Allen/Roe to be curved for the benefits disclosed in Goyal.

10. Claims 56-59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roe view of Glaug et al. USPN 6258076.

As to claims 56 and 57, Roe discloses the present invention substantially as claimed. However, Roe does not disclose a front guard extending vertically from the front portion to a middle chest area of a user. Glaug discloses a disposable absorbent

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article comprising a vertical extension (in use) barrier wall for that is present on the front and rear portions of the diaper (Figure 4, for the benefit of impeding the egress of the loose or liquid waste from the front waist portion of the disposable absorbent article (Glaug col. 4, lines 7-11). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the diaper of Roe to have a vertically extending front guard for the benefits disclosed in Glaug.

Roe/Glaug discloses an incontinence article **20** comprising a front portion **34**, a rear portion **38**, and a back guard **62** extending vertically from the rear portion to a middle back area of a user (Roe Figures 1 and 6; col. 1, lines 43-45 and col. 9, lines 38-41). Roe further discloses the back guard further comprises a flap **92** that may be made of any known material suitable for use in a disposable absorbent article, such as the same material as the topsheet (Roe col. 4, lines 41-44 wood or cotton fibers and rayon fibers, which are all absorbent materials). The flap **92** is centrally located centrally on the back guard (Roe Figures 10 and 11).

The vertical extension of Roe is capable of extending to a middle back area of a user. For instance, is the elongated diaper of Roe is designed to adjust to the size of various users (Roe col. 7, lines 55-62). Therefore, if the diaper is placed on a smaller infant, the diaper would extend to a middle back area of the infant as opposed to the same diaper being used on a toddler.

As to claim 58, Roe/Glaug discloses the back guard comprises elastics and the guard is elastically extensible in one or more directions. However, Roe/Glaug is silent

as to where the elastic is positioned. The back guard of Roe/Glaug serves to elongate the diaper so it can fit a variety of users, and is elastically extensible for this purpose. It would have been an obvious matter of design choice to have the elastic materials on the entire back guard or on the periphery, since either structure would elongate the back guard so as to fit a variety of users and contain exudates, and since applicant has not disclosed limiting the elastic to the periphery solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with the elastic in other regions of the back guard.

As to claim 59, Roe/Glaug does not disclose the back guard has a length of approximately 1.0 – 10.0 inches. It is evident that Roe has a value for the length of the back guard. Roe recognizes the length of the back guard should be sufficient to adjust in length to fit a large range of wearer sizes and to provide an absorbent article, which can be fitted to a wearer in a high-back configuration (Roe col. 1, lines 39-45). It would have been an obvious matter of design choice to provide the article of Roe with the claimed dimensions, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

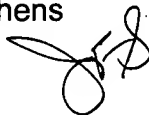
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacqueline F Stephens whose telephone number is (703) 308-8320. The examiner can normally be reached on Monday-Friday 9:00-5:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Calvert can be reached on (703)305-1025. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jacqueline F Stephens
Examiner
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June 10, 2004